related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not require restriction. See MPEP § 803.02.

Concerning the claims of the present application, claims 1-10 and 12-36 are drawn to a series of conopeptides. Applicants agree that the various conopeptides are distinct from each other. However, as stated in the MPEP as discussed above, distinctness alone is not enough to require a restriction. There must also be a serious burden upon the examiner. In the absence of such a burden the examiner must examine all of the claims (or in this case it is urged that all of the peptide claims should be examined). It is urged that the burden of examining all of the peptide claims of the present application is not a serious burden and that the burden of examining all of the peptide claims is only slightly greater than examining one of the groups of claims.

The examination entails various aspects. First is a decision concerning utility under 35 U.S.C. § 101. Although each protein species being claimed is distinct, they are all related and the claimed utilities for them are all identical (see page 8, lines 18-21, of the application). Consequently, a decision concerning utility will be identical for all of the species and there is no added burden of examining all of the species as compared to examining only a single species.

The second aspect of examination is whether the various paragraphs of 35 U.S.C. § 112 have been met. In general and in this case this means reviewing the application and claims for compliance with paragraphs 1 and 2 of § 112. As for the enablement aspect as found in paragraph 1 of § 112, all of the peptides have similar structures and the examiner has not set forth any basis for distinguishing the enablement of one species as compared to any other claimed species. Since no basis for distinguishing between the enablement of one species vs. another species has been set forth, it is presumed that all of the listed peptides will be treated equally. Again, this means that only a single decision needs to be made concerning all of the peptides. Therefore this aspect of the examination will not be a serious burden if all peptides are examined vs. only one of the peptides.

Concerning paragraph 2 of § 112, this involves the wording of the claims. The wording of the claims in each group of claims is identical except for the specified peptide. Consequently any objections to the language of the claims for one Group of claims is equally applicable to the

other Groups of claims. Therefore there is no increase in the burden concerning 35 U.S.C. § 112, second paragraph, if all peptide claims are examined.

The third aspect of examination is a review of prior art to determine whether the claims are anticipated or obvious. There are two aspects of such a search. A first aspect is a review of the prior art literature and patents. The literature to be reviewed will be identical for all of the peptides. All of the claimed peptides have similar, though not identical, structures and all are claimed to have the same utility. The examiner has not stated that a search of the scientific literature will be any different for one peptide than it will be for any other peptide. The Office Action states that all of the claims are classified in class 530, subclass 300. Consequently the search of the patent literature will clearly be the same for all of the peptides. Because the search of the scientific literature and patent literature will be identical for all of the peptides there is no added burden concerning this aspect if all of the peptides are examined.

The second aspect of the prior art search concerns a sequence search. In this case, the inclusion of all of the peptides as opposed to an examination of only one of the peptides will involve a broadened search. Nonetheless, it is urged that this increased burden is not a serious burden. This type of searching is computerized and the sequence data is already electronically available. The performance of an electronic search of the 15 claimed peptides against GenBank or other database is extremely rapid and is performed by STIC, not by the examiner. The examiner merely needs to review the output of the search and it is an easy matter to review the printout to determine whether a specific peptide was found to be known in the prior art databases which were searched. As noted, to review 15 such printouts is an added burden, but it is not a serious burden. Furthermore, there is really only 1 search, not 15 searches, which is necessary. SEQ ID NO:1 is a generic formula which is inclusive of all possible peptides described by SEQ ID NOs:2-15. SEQ ID NOs:2-5 are generic formulas which describes peptides falling within SEQ ID NO:1 but the peptides of SEQ ID NOs:2-5 are more particularly specified and are a subset of the peptides of SEQ ID NO:1. Each of SEQ ID NOs:6-15 describes a very limited genus with the variability within each genus being the choice of Trp or 6-bromo-Trp at Xaa_1, Glu or γ-Glu at Xaa_2, and Pro or Hyp at Xaa_3. Thus SEQ ID NOs:6-15 can almost be considered to each represent a single species with each species falling within the sequence defined by SEQ ID NO:1. Consequently a search of SEQ ID NO:1 will reveal all relevant sequences, if any, which apply to SEQ ID NOs:2-15. Because Group I which is drawn to peptides of SEQ ID NO:1 is

being elected, it is urged that the results of the search which will be performed will be inclusive of the search results which would be obtained if SEQ ID NOs:2-15 were to be searched. Consequently, a separate search of SEQ ID NOs:2-15 would be redundant.

Also, as just noted, the claims of Groups II-XV are drawn to subgenuses or species which fall into the generic claim of Group I. Because the claims are related as genus and subgenus or species they should not be divided. An examination of the species claims can add no burden to the examination required for the genus.

Furthermore, MPEP § 808.02 states that where the related inventions as claimed are shown to be distinct, the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: 1) Separate classification thereof; 2) A separate status in the art when they are classifiable together; or 3) A different field of search. The Office Action mailed 28 March 2000 fails to meet this requirement of MPEP § 808.02. First, there is no separate classification of any of the peptide claims. Therefore the first possibility is not met. Second, there is no statement in the Office Action that the various peptides have a separate status in the art and it is urged that there is no separate status, all of the peptides being similar, although different, in structure and in activity. Concerning the third possible reason, that of a different field of search, again no statement was made that the various peptides require a different field of search and it is asserted that there is no distinction between the peptides to require a different field of search. Although the 15 different peptide sequences may be searched in the sequence databases, the searches will be identical except for the sequence being used, i.e., the same databases and same type of search will be performed for each peptide.

Finally, the only reason stated in the Office Action for the restriction is that "these inventions are distinct for the reasons given above [the peptides are structurally and physically different protein peptides] and have acquired a separate status in the art because of their recognized divergent subject matter as shown by the different classification". But of course the different classification refers only to the differences between nucleic acids and peptides, and the nucleic acids are not at issue here. Consequently, the Office Action is left with the only reason for restriction being that the peptides are distinct from each other. But as explicitly stated in MPEP § 803, the inventions must be distinct and there must be a serious burden on the examiner. MPEP § 803.02 states that if a search and examination of an entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are